

Docket No.: 27295/38258
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Patricia L. Conway et al.

Application No.: 09/889,085

Confirmation No.: 6842

Filed: January 9, 2002

Art Unit: 1657

For: IMPROVED MICROBIAL PREPARATIONS

Examiner: V. Afremova

PETITION UNDER 37 CFR 1.182 AND
REQUEST FOR WITHDRAWAL OF HOLDING OF ABANDONMENT AND
REQUEST TO RE-OPEN PROSECUTION

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This petition is filed in response to the Notice of Abandonment mailed October 7, 2008, in which the present application was held abandoned. Applicants hereby request withdrawal of the holding of abandonment and request re-opening of prosecution under 37 CFR § 41.50. The holding of abandonment is in error because 1) there were new grounds of rejections in the Decision on Appeal and an Amendment was timely filed, and 2) the petition requesting re-opening of prosecution under 37 CFR § 41.50 was granted.

Prosecution should have been re-opened under 37 CFR § 41.50 because the Decision on Appeal dated December 29, 2006, included new grounds of rejection and an Amendment with a request to re-open prosecution was timely filed with the Patent and Trademark Office (PTO). Furthermore, a petition dated April 16, 2007, requesting that prosecution be re-opened under 37 CFR § 41.50 was granted June 2, 2008. A few months after the petition granting the re-opening of prosecution, the PTO issued a holding of abandonment on October 7, 2008. The Applicants respectfully request the withdrawal of the holding of abandonment.

New Grounds of Rejection in the Decision on Appeal

On December 29, 2006, the Decision on Appeal issued a new grounds of rejection regarding harvested microbes stating

Because the Examiner did not rely on this disclosure in the rejection of record, we designate this a new grounds of rejection in order to give Appellants the opportunity to respond to it. 37 C.F.R. § 41.50(b).

Decision on Appeal at p. 9, lines 15-18. On February 28, 2007, Appellants timely filed a response to the Decision on Appeal rendered December 29, 2006 (which was confirmed by the granting of the petition requesting re-opening of prosecution under 37 CFR § 41.50). Under the provisions of 37 CFR § 41.50, a request that complies with the provisions will be entered, the application will be reconsidered by the examiner, and the request to re-open prosecution will be treated as a request to withdraw the appeal.

Here, there was a new grounds of rejection regarding the anticipation rejection over Masuda. The new grounds of rejection was based on the limitation in claim 41 of “harvesting” microbes. Although claim 41 is currently canceled, each pending independent claim (77, 79, 81, and 88) contains the “harvest” limitation. Therefore, the new grounds of rejection applies to the pending claims, and prosecution should have been re-opened under 37 CFR § 41.50.

Petition Granting Re-Opening of Prosecution

Appellants filed a petition under 37 CFR § 1.182 requesting re-opening of prosecution under 37 CFR § 41.50 on April 16, 2007, with a copy of the timely filed response. This petition was granted on June 2, 2008. The Appellants telephoned the primary examiner on October 15, 2008, and November 6, 2008, in an attempt to re-open prosecution in accordance with the previously-granted petition. On November 13, 2008, Examiner Afremova stated that she and her supervisor believed there were no “actual” new grounds of rejection in the Decision on Appeal, but invited the undersigned to consult with Quality Assurance Specialist Robert Wax.

Robert Wax referred the undersigned to Examiner Jon Weber, who was on vacation for a period, but ultimately referred the undersigned to Examiner Michael Wityshyn.

On January 5, 2009, Examiner Wityshyn invited the undersigned to consider filing a petition to withdraw abandonment, but to contact Examiner Weber first. The undersigned has been unable to reach Examiner Weber and, accordingly, Appellants submit this Petition because, as shown above, the Decision on Appeal specifically stated new grounds of rejection. Therefore, Appellants' timely response and subsequent granted petition to re-open prosecution should have been sufficient to re-open prosecution.

Therefore, Appellants respectfully request re-opening of prosecution and enclose herewith the petition processing fee under 37 CFR 1.17(f) in the amount of \$400.00. Withdrawal of the holding of abandonment is respectfully solicited and given that the reply was timely filed and the petition re-opening prosecution was granted, Appellants respectfully request a refund of the petition processing fee.

Dated: February 3, 2009

Respectfully submitted,

By 

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